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Date: September 15, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Marc Husemann and Stephan Zöllner
Serial No. : 10/800,341
Filed : March 12, 2004
For : LOW SHRINKBACK HOTMELT PSA, ITS PREPARATION
AND USE
Art Unit : 1713
Examiner : William K. Cheung

September 15, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.37

Sir:

This is an appeal from the final rejection of an Examiner of Art Unit 1713.

1. REAL PARTY IN INTEREST

The instant application is owned by tesa AG, record owner hereof.

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2. RELATED APPEALS AND INTERFERENCES

The undersigned is not aware of any appeals, interferences, reexaminations,

infringement actions or the like in any related applications.

3. STATUS OF CLAIMS

The claims pending in this application are claims 1-5 and 7-29. Claims 10-15 and 18-29 have been withdrawn from consideration as drawn to non-elected subject matter, so that the claims under consideration are claims 1-5, 7-9, 16 and 17. Claims 1-5, 7-9, 16 and 17 are finally rejected and all of said claims are on appeal.

4. STATUS OF AMENDMENTS

The last amendment filed was a Rule 111 Amendment filed March 29, 2005 (by facsimile) and that amendment was entered.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 relates to a novel hotmelt pressure sensitive adhesive comprising at least one polyacrylate component which is substantially free from polar groups and a filler comprising calcium carbonate (page 3, lines 10-18). The novel hotmelt pressure sensitive adhesive exhibits a shrinkback after extrusion of not more than 5% (page 3, lines 22-24). Through the addition of calcium carbonate (i.e. chalk) and the avoidance of carboxyl- or hydroxyl-containing comonomers, the shrinkback properties of the adhesives surprisingly are substantially reduced as compared to similar adhesives not so formulated (page 21, second paragraph).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are

- A) The rejection of claims 1, 3-5, 7-9, 16 and 17 under 35 USC 103(a) as obvious over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US

6,472,025).

B) The rejection claim 2 under 35 U.S.C. 103(a) as obvious over Massow et al. (US 5, 194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1).

7. ARGUMENTS

A) The rejection of claims 1, 3-5, 7-9, 16 and 17 under 35 USC 103(a) as obvious over Massow et al. (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025)

The Examiner sees the Massow reference as disclosing an acrylate based hotmelt pressure-sensitive adhesive which can contain fillers, and Guldbrandsen as disclosing pressure-sensitive adhesives which can have fillers, such as chalk. The Examiner contends that it would be obvious to use Guldbrandsen's chalk filler in Massow's adhesive to somehow arrive at Appellants' adhesive.

Massow's polyacrylate is a very specific copolymer of an acrylate monomer with N-tert.-butylacrylamide; whereas Guldbrandsen is specific to low molecular weight acrylate hotmelts. Guldbrandsen lists a variety of fillers, and does not single-out chalk as being any different than any other filler, or as having any special advantages when combined with any special polyacrylate.

Appellants have discovered and, by their examples, demonstrate **unexpected results** for hotmelt pressure-sensitive adhesives meeting the parameters of Claim 1. More specifically, Appellants have made the surprising and unexpected discovery that the addition of calcium carbonate to their specific hot-melt pressure sensitive adhesive produces an unforeseen improvement in the shrinkback properties of the adhesive. This is demonstrated by Appellants' Examples, as shown by the data of Table 1, found on page 20. In this regard, it should be noted that the only difference between reference examples 1 and 2 and inventive examples 3 and 4 is the presence or absence carboxyl- or hydroxyl- containing monomers and the presence or absence of chalk.

To this, the Examiner responds that he has a reasonable basis to believe that the addition of fillers to a matrix resin would improve shrinkback properties of the claimed adhesive and that in his opinion Appellants unexpected results are "expected". The Examiner's position is, of course, based on sheer speculation and he has not produced one shred of evidence to support his speculative conclusions. The Examiner has not pointed to anything that would teach or suggest that the addition of fillers to an acrylate based hotmelt pressures sensitive would reduce shrinkback. The Examiner's *speculation* cannot rebut Appellants' showing of unexpected results.

Moreover, the Examiner overlooks the claim limitation that the pressure-sensitive adhesive composition must be substantially free of carboxyl or hydroxyl groups. The Massow reference teaches that monomers which contain carboxyl groups are

preferred (col. 4, line 18), as are those having hydroxyl groups (col 4, line 20). Massow therefore teaches away from Appellants' novel pressure sensitive adhesive composition.

Accordingly, no combination of Massow and Guldbrandsen could possibly lead to Appellants' novel low-shrinkback pressure-sensitive adhesive, and the rejection of claims 1, 3-9, 16 and 17 under 35 USC 103(a) as unpatentable over Massow et al. (US 5,194,455) in view of Guldbrandsen et al (US 6,472,025) should be REVERSED.

B) The rejection claim 2 under 35 U.S.C. 103(a) as obvious over Massow et al. (US 5, 194,455) in view of Guldbrandsen et al. (US 6,472,025) and further in view of Lai (US Pub. 2003/0120101 A1).

The Examiner relies on Lai for a molecular weight of less than 500,000. The copolymer of Lai is, however, a completely different polymer than that of Massow or Guldbrandsen, and the Examiner has not shown why anyone would want to make the polymers of Massow or Guldbrandsen in the molecular weight range of e.g. 600 – 3500 disclosed by Lai. The Examiner has not shown anything in any of the references that would suggest this. More specifically, the Examiner has not shown any *motivation* for his proposed combination of references.

Even if, however, any product that could be derived from the Massow/
Guldbrandsen combination of references were to be made in the molecular weight
range disclosed by Lai, Appellants' demonstration of unexpected advantages, as
discussed above, would not be overcome.

Accordingly, claim 2 cannot be seen as obvious over Massow and Guldbrandsen
in further view of Lai, and the rejection of claim 2 under 35 U.S.C.103(a) as obvious
over Massow et al (US 5,194,455) in view of Guldbrandsen et al. (US 6,472,025) and
further in view of Lai (U.S. Pub. 2003/0120101) should now be REVERSED.

8. CONCLUSION

Wherefore it is submitted that the final rejection is in error and should be
REVERSED.

AUTHORIZATION TO CHARGE FILING FEE TO DEPOSIT ACCOUNT

Appellant is:

☐ a small entity

☒ other than a small entity

It is requested that the fee for the filing of the Brief on Appeal be charged to the
undersigned's Deposit Account No. 14-1263.

Please charge:

- [] \$ 250.00 for small entity
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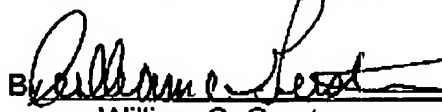
CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Appellants request that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

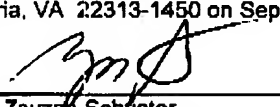
Respectfully submitted,
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I hereby certify that this correspondence is being transmitted via facsimile, no. 571-273-8300 to the United States Patent and Trademark Office, addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 15, 2006.

By 
Zsuzsa Schuster
Date September 15, 2006

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9. CLAIMS APPENDIX

The claims are appeal read as follows:

Claim 1. A hotmelt pressure sensitive adhesive comprising at least one polyacrylate component and an added filler comprising calcium carbonate, wherein said at least one polyacrylate component

- is formed from monomers comprising least 50% by weight, of at least one acrylic or methacrylic ester, or both, of the formula (I)



where $\text{R}_1 = \text{H}$ or CH_3 and R_2 is an unbranched, branched or cyclic alkyl radical having 1 to 22 carbon atoms and

- is substantially free of carboxyl or hydroxyl groups.

Claim 2. The adhesive as claimed in claim 1, wherein said at least one polyacrylate component has a weight average molecular weight M_w of not more than 500 000 g/mol.

Claim 3. The adhesive as claimed in claim 1, wherein the added filler comprising calcium carbonate is chalk.

Claim 4. The adhesive as claimed in claim 1, wherein the amount of said added filler comprising calcium carbonate is at least 10% wt., based on the weight of polyacrylate component.

Claim 5. The adhesive as claimed in claim 1, having a shrinkback, after extrusion coating, of not more than 5%.

Claim 7. The adhesive as claimed in claim 1, wherein R_2 is selected from the group consisting of unbranched, branched, and cyclic C_4 to C_{14} alkyl radicals.

Claim 8. The adhesive as claimed in claim 7, wherein R_2 is selected from the group consisting of bridged or unbridged, alkylated or unalkylated cycloalkyl radicals having at least 6 carbon atoms.

Claim 9. The adhesive as claimed in claim 7, wherein the at least one acrylic and/or methacrylic ester of formula (I) is selected from the group consisting of methyl acrylate, methyl methacrylate, ethyl acrylate, n-butyl acrylate, n-butyl methacrylate, n-pentyl acrylate, n-hexyl acrylate, n-heptyl acrylate, n-octyl acrylate, n-octyl methacrylate, n-nonyl acrylate, lauryl acrylate, stearyl acrylate, behenyl acrylate, isobutyl acrylate, 2-ethylhexyl acrylate, 2-ethylhexyl methacrylate, isooctyl acrylate, isooctyl methacrylate, cyclohexyl methacrylate, isobornyl acrylate, isobornyl methacrylate, and 3,5-dimethyladamantyl acrylate.

Claim 16. The adhesive as claimed in claim 1, further comprising at least one resin component selected from the group consisting of pinene resins, indene resins, and rosins, and their derivatives and salts; aliphatic, aromatic and alkylaromatic hydrocarbon resins, hydrogenated hydrocarbon resins; substituted and unsubstituted hydrocarbon resins, natural resins, terpene resins, and terpene-phenolic resins.

Claim 17. The adhesive as claimed in claim 1, further comprising one or more additives selected from the group consisting of plasticizers, nucleators, expandants, compounding agents, aging inhibitors, crosslinkers and promoters.

10. EVIDENCE APPENDIX

No evidence under §§ 1.130, 1.131, or 1.132 has been submitted.

11. RELATED PROCEEDINGS APPENDIX

There have been no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37